

REMARKS

The Specification has been amended. Claims 3, 5, 7 - 9, 11 - 13, 21, 24 - 27, and 31 have been amended to more clearly specify the subject matter which Applicants regard as their invention. Claims 32 - 33 have been added. No new matter has been introduced with these amendments or added claims, all of which are supported in the specification as originally filed. Claims 1 - 2, 6, and 10 have been cancelled from the application without prejudice. Claims 3 - 5, 7 - 9, and 11 - 33 are now remain in the application.

I. Objection to the Claims

Paragraph 4 of the Office Action dated October 4, 2006 (hereinafter, "the Office Action") states that Claims 13 and 24 are objected to. Appropriate corrections have been made herein, and the Examiner is respectfully requested to withdraw the objections to the claims.

II. Rejection under 35 U. S. C. §112, Second Paragraph

Paragraph 7 of the Office Action states that Claim 1 is rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential steps. Claim 1 has been cancelled from the application, rendering the §112, second paragraph, rejection moot.

III. Rejection under 35 U. S. C. §101

Paragraph 10 of the Office Action states that Claim 24 is directed to non-statutory

subject matter. Appropriate amendments have been made herein, and the Examiner is respectfully requested to withdraw the §101 rejection.

IV. Rejection under 35 U. S. C. §103(a)

Paragraph 12 of the Office Action states that Claims 1 - 23 and 27 - 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Publication 2004/0133595 to Black in view of U. S. Patent Publication 2004/0002952 to Lee et al. (hereinafter, “Lee”).

Paragraph 13 of the Office Action states that Claims 24 - 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Black. Claims 1 - 2, 6, and 10 have been cancelled from the application without prejudice, rendering the rejection moot as to those claims. The rejections are respectfully traversed with regard to the remaining claims.

Referring first to independent Claim 13, Applicants respectfully submit that neither of the references, nor a combination thereof, teaches all of the limitations of this claim. Claim 13, as amended, specifies (emphasis added):

A computer-implemented method of casting objects, comprising steps of:
 validating syntax elements of an input, using a validating parser,
 according to a first syntax level while generating output objects, from the input
 using the validating parser, according to a second syntax level, wherein the
 generating further comprises suppressing, by the validating parser, at least one
 of the validated syntax elements from the generated output objects in order that
the generated output objects will be valid according to the second syntax level;
and

 providing the generated output objects for use by an application
 program.

Claim 13 is discussed on p. 9, line 17 - p. 10, line 17 of the Office Action. The cited text from Black comprises paras. [0028] and [0039]; **Fig. 4A**, steps 203 and 206; and reference numbers 139 and 141. Applicants respectfully submit that these citations do not teach, or suggest, that a validating parser validates syntax elements “according to a first syntax level while generating output objects ... according to a second syntax level” (Claim 13, lines 3 - 5, emphasis added). Furthermore, these citations do not teach, or suggest, “suppressing, by the validating parser, at least one of the validated syntax elements from the generated output objects in order that the generated output objects will be valid according to the second syntax level” (Claim 13, lines 5 - 7, emphasis added).

In fact, lines 9 - 10 on p. 10 of the Office Action admit that Black “fails to explicitly disclose the further limitation of validation of the input”. Lee is then cited as providing this missing limitation, and in particular, Lee’s Abstract and para. [0023] are cited. While these passages from Lee do discuss “validation”, they are discussing an external (i.e., separate) validator. See, for example, the last sentence of the Abstract and reference number 232 of **Fig. 2**, where the validator is shown as distinct from the XML parser 211. This is not pertinent to Applicants’ claim language, where the validating parser is doing both the “validating” (Claim 13, line 3) and the “generating” of the output (Claim 13, line 4) – as well as the “suppressing” (Claim 13, lines 5 - 6).

Section 706.02(j) of the MPEP, “Contents of a 35 U.S.C. 103 Rejection”, states the

requirements for establishing a *prima facie* case of obviousness under this statute, noting that three criteria must be met. These criteria are (1) a suggestion or motivation, found either in the references or in the knowledge generally available, to modify or combine the references; (2) a reasonable expectation of success; and (3) the combination must teach all the claim limitations. This text goes on to state that “The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.”. The three requirements for establishing a *prima facie* case of obviousness are also stated in MPEP §2142, “Legal Concept of *Prima Facie* Obviousness”, and MPEP §2143, “Basic Requirements of a *Prima Facie* Case of Obviousness”.

Because neither of the references teaches, or suggests, the above-discussed limitations from independent Claim 13, the third requirement for a *prima facie* case of obviousness has not been met. Accordingly, Claim 13 is deemed patentable over the references. See *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.

Referring next to independent Claim 24, this claim is discussed on p. 17, line 6 - p. 18, line 18 of the Office Action. The Office Action admits, on p. 17, lines 15 - 17, that Lee fails to “explicitly disclose second means for using the validating parser to apply abstraction ...”, and then states that the missing limitations are taught by Black. Applicants respectfully disagree. The discussion on p. 18, lines 5 - 8 of the Office Action states that “adding,

modifying or deleting elements is considered to represent changing the syntax level of markup document 139". In fact, such editing changes the syntax of the markup document itself, but does not change the "syntax level" according to which a validating parser performs validation of the markup document (in contrast to the limitations specified in Claim 24, lines 4 - 6). That is, the syntax level used by a validating parser for validating a document is the grammar for the document's syntax, as is well known in the art, where the grammar for a markup language document is typically specified in a DTD or schema. (Applicants note that Black has not illustrated the DTD or schema that corresponds to input document 139 and its DOM tree 141, and Applicants find no discussion nor any suggestion in Black of using a different DTD or schema while working with input document 139.) Changing the markup language document by "adding, modifying or deleting elements" does not change the document's DTD or schema (and instead, when using Black's conventional treatment of DTDs and schema, this type of document editing leads – as is known in the art – to a changed document that must still adhere to the original DTD or schema of the markup language document).

Accordingly, these citations from Black do not teach, or suggest, the claim language of Applicants' Claim 24. Given the admission on p. 17, lines 15 - 17 that Lee fails to teach all limitations of Claim 24, Applicants respectfully submit that a *prima facie* case of obviousness cannot be made out with regard to Claim 24 by combining Lee with Black. Without more, Claim 24 is deemed patentable.

Referring next to independent Claim 26, this claim is discussed on p. 19, line 1 - p. 20,

line 10 of the Office Action. In particular, p. 19, lines 8 - 10 admit that Lee fails to “explicitly disclose ... generating one or more output objects according to a second schema”. Black is then cited as teaching the missing limitations. Applicants respectfully disagree with this characterization of Black. Refer to the discussion, above, of Applicants’ independent Claim 24, which clarifies that Black’s discussions pertain to editing a markup language document, and not to editing (or otherwise changing) the DTD or schema that specifies allowable syntax for that markup language document. Accordingly, Applicants’ Claim 26 is deemed patentable over the references in a similar manner to that which has been described, above, for Claim 24.

Referring next to independent Claim 31, this claim is discussed in the Office Action on p. 15, line 13 - p. 17, line 2. The Office Action admits, on p. 16, lines 9 - 12, that Black “fails to explicitly disclose ... the parser being a validating parser and of validating the input document with the provided validating parser, wherein the validation is performed according to a first syntax level ...”. Lee is then cited as teaching the missing limitations. However, as has been discussed above with regard to independent Claim 24, the “adding, modifying or deleting” that is discussed on p. 16, lines 1 - 8 of the Office Action with regard to Black does not pertain to changing to a different “syntax level”, as that term is used in Applicants’ claim language. Instead, Black is discussing editing of the markup language document itself, and – according to Black’s conventional treatment of DTDs and schema – this editing must yield a changed document that adheres (as is known in the art) to the original DTD or schema of the document.

Accordingly, Applicants respectfully submit that neither Lee nor Black, nor a combination thereof, teaches all of the limitations of their independent Claim 31. Without more, Claim 31 is deemed patentable.

Dependent Claims 3 - 5, 7 - 9, 11 - 12, 14 - 23, 25, and 27 - 30 are deemed patentable by virtue of the patentability of the independent claims from which they depend.

In view of the above, the Examiner is respectfully requested to withdraw the §103 rejections.

V. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding objections and rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

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